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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,495	07/18/2001	Rolf Skold	2964-0106P	4188
2292	7590	12/09/2003	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			HAMLIN, DERRICK G	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 12/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/889,495	SKOLD, ROLF	
	<b>Examiner</b>	<b>Art Unit</b>	
	Derrick G. Hamlin	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 18 July 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 11-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 11-19 is/are rejected.
- 7) Claim(s) 20-22 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> -Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                     |

**DETAILED ACTION*****Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tichner et al. (4,342,658).

Tichner discloses a Hydraulic fluids or metalworking lubricants are prepared utilizing mixture of water and, as lubricants and corrosion inhibitors, an alkyl dialkanolamide, a polyoxyethylene ester, and an ethoxylated alkylaryl phosphate ester. The compositions have improved extreme pressure lubricating and wear preventing characteristics and are non-flammable. The compositions can be thickened if desired using a polyglycol-type thickener and can contain conventional corrosion inhibiting and extreme pressure lubricating additives known in the prior art. Stable concentrates comprising a phosphate ester a polyoxyethylene ether, and an alkyl alkanolamide can be prepared. (abstract) The reference teaches a water-based fluids or metalworking composition can be obtained by blending water in a major proportion with minor

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effective lubricating amounts of a mixture of a phosphate ester a polyethylene ester, a polyester of an oxyalkylene compound, and an alkyl dialkanolamide (col. 1, lines 48-53).

The reference discloses a class of phosphates, which corresponds to those instantly claimed (col. 2, line 17-26). The reference teaches the use of a diacid containing 21 carbons which is clearly between the suggested 4-40 carbon range (col. 7, line 63 – col. 8 line 3).

The reference fails to teach all of the specific succinic acids as claimed in the claims. Although the reference fails to teach all of the specific succinic acids claimed, the reference does teach the general class of compounds and the required amounts. Therefore, in the absence of superior or unexpected results, the reference would read on the specific instantly claimed compounds. The reference also fails to teach all the instantly claimed components in one composition. Although the reference also fails to teach all the instantly claimed components in one composition, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to practice the instantly claimed method, in view of the references teaching of metalworking lubricants composition made by mixing water, an alkyl dialkanolamide, a polyoxyethylene ester, and an ethoxylated alkylaryl phosphate ester with a diacid.

#### ***Allowable Subject Matter***

Claims 20-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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The reference fails to teach all of the instantly claimed components in the instantly claimed amounts nor the composition made using the instantly claimed method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick G. Hamlin whose telephone number is (703) 305-0590. The examiner can normally be reached on Monday-Thursday and alternating Fridays from 8:30 AM - 5:00 PM.

If reasonable attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Derrick G. Hamlin

12/1/03



*Lorna M. Douyon*  
LORNA M. DOUYON  
PRIMARY EXAMINER